



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,846	01/11/2002	Takaaki Shibata	393032030000	1148
25224	7590	10/20/2005		
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			EXAMINER SMITH, CREIGHTON H	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/043,846	SHIBATA ET AL.	
	Examiner	Art Unit	
	Creighton H. Smith	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 SEP '05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 9-15 are is/are pending in the application.
- 4a) Of the above claim(s) 5 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,7 and 9-13 is/are rejected.
- 7) ☒ Claim(s) 3, 14, 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The specification is objected to under 37 CFR 1.71 because the specification as originally filed does not provide support for the invention as now claimed. At least in claim 1, applicant now proposes to add the limitation to the claim that the communication terminal is not connected to the server. However, on page 16 of applicant's spec. says just the opposite of what applicant has now attempted to place in the claim, i.e., that the communication terminal is connected to the server apparatus that provides the musical tone data distributing service via the network. Not only is what applicant now proposes to add to claim 1 inconsistent with what is disclosed in the spec., but it is contrary to what the spec discloses. Therefore, applicant is required to delete this language from claim 1 and any other claims that it appears in.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6, 7, 9-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter that applicant has not properly described is the limitation to the independent claims as how the communication terminal is not connected to the server, in view of what is disclosed on page 16, lines 17-20.

Art Unit: 2645

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6, 7, 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Application Publication #2004/0007120 to Futamase et al.

Examiner does not agree with applicant's arguments that Futamase fails to disclose that the display is for receiving the musical tone distributing service. Futamase's base station (server), [0031], is the musical tone data distributing service. In [0031], Futamase et al disclose that "[u]pon transmission of the information associated with the terminal . . . to the base station (server), the music tone information service system and the base station can perform format conversion at the base station on the basis of the information concerned. In [0014], Futamase et al disclose a tone generation control device operative based on the memorized performance information for sequentially generating a music tone signal, and a display means operative based on the memorized words information for generating a words display signal corresponding to the generated music tone signal. Therefore, the musical tone data that is downloaded from the base station server and stored in the cell phone's memory as a ring tone, is then displayed on the phone's LCD when the phone rings.

Futamase et al disclose in their Abstract a portable terminal that will play a music tone. In [0135], Futamase et al disclose that the terminal TS starts a request information send module (S1) and calls the base station, i.e., the server, through the terminal's transmitter (6), requesting the server base station to download information from the BS server's database. To be more specific, Futamase et al disclose, during talking with the server BS, music information, performance information, for example, stored in the server's database are displayed on the terminal's display (13). The user of the terminal will then operate keys on the terminal's keypad to enter numbers indicative of those pieces of information and then executes a request. Futamase et al disclose that their portable terminal is a telephone terminal [0001], i.e., a communication terminal capable of playing/sounding a musical tone, [0008]. In [0010], Futamase et al disclose a portable terminal comprising a "storage means" for storing music tone information, audio information, and video information, and a "generating means" for the audio and video information stored in the storage means. In [0014] Futamase et al disclose a display means (13) that operates based on the word information (of the tone) and will generate a words display corresponding to the generated music tone. This means that the written words to a song will be displayed on a cell phone's LCD as the musical tones are emanating from the phone's speaker. In [0021], Futamase et al discloses the tone generating device that will play the stored music/tones in the cell phone's storage device. The data coming into Futamase et al cell phone is from the base station's server ion the form of streaming data, [0033]. Streaming data is sent over the Internet

Art Unit: 2645

as disclosed in Newton's Telecom Dictionary, and hence is uploaded from Futamase et al server to the requesting cell phone's storage device.

Therefore, Futamase et al portable telephone terminal will display data associated with a musical tone, [0014]; their portable telephone has a device that will receive musical tone data via the Internet network because in order to "play" data along with its associated musical notes there must inherently be a device on the cell phone that receives the data. As mentioned supra, Futamase discloses in [0010] a storage means that will store musical, audio, & video information. Both the audio and video information meets applicant's limitation of storing a "predetermined program" in a program receiving device. Although Futamase et al never specifically discloses that their musical, audio, and video are stored in advance, it only seems inherent that if the music, audio, and video are stored at all, then they are stored in advance to when the user desires to view or hear the stored media means. If the user is storing melody tones along with the data to go along with the melody, so that when the cell phone receives a phone call the melody will play along with the words being displayed on the phone's display, then the predetermined program, i.e., audio & video, is being stored in advance.

For claim 2, the first display data reads on any type of data being displayed on the phone's LCD display.

Claims 3,14, 15, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Futamase et al nor any of the rest of the prior art teach the display area on the user's mobile phone having a second data display

Art Unit: 2645

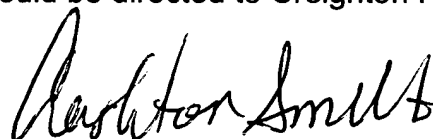
that represents a list of "occasionally updated phone data". Neither does the prior art teach that the predetermined programs are stored in the cell before the musical tone data is received from the server.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Creighton H. Smith at telephone number 571/272-7546.

17 OCT '05

A handwritten signature in black ink, appearing to read "Creighton H. Smith".

Creighton H Smith
Primary Examiner
Art Unit 2645